

REMARKS

This is intended as a full and complete response to the Final Office Action dated October 8, 2004, having a shortened statutory period for response set to expire on January 8, 2005. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-18, 23-34 and 49-50 are pending in the application. Claims 1, 3-5, 8, 23, 26 and 30 have been amended. Claim 24 has been canceled. Applicants submit that the amendments do not introduce new matter or raise new issues.

Claim Rejections - 35 USC § 101

Claims 23-34 and 50 are rejected under 35 U.S.C. §101. The Examiner states that the "claims do not produce a "useful, concrete, tangible result" and that "claims 23-34 and 50 clearly read on a computer printout of the software program (implemented with e.g. Java, C++, or perhaps other computer code) which does not "produce a useful, concrete, tangible result." Although Applicants believe that claims 23-34 and 50 qualify as statutory subject matter, to facilitate prosecution of the claims on their merits, Applicants have canceled claim 24 and amended independent claim 23 to include limitations previously presented in claim 24. Applicants respectfully traverse this rejection.

First, Applicants submit that independent claim 23, as amended, and those depending therefrom, qualify as statutory subject matter through the determination process laid out in Appendix A-2 of the USPTO's *Examination Guidelines for Computer-Related Inventions*. Applying the determination process, the limitations incorporated from previously presented claim 24 include independent physical acts (i.e., "outputting to the user, from an outputting device of the vending machine, an indication of the availability of the item at the at least one other vending machine"), and thus, the claims qualify as statutory subject matter. Furthermore, even if the Examiner does not consider such output as an independent physical act, Applicants submit that the claims do not merely manipulate abstract idea solves a purely mathematical problem without

any limitation to a practical application because the claims clearly recite limitations regarding practical applications in determining availability of an item and outputting an indication of availability to the user, and thus, once again arriving at the determination that the claims qualify as statutory subject matter.

Secondly, Applicants submit that independent claim 23, as amended, and those depending therefrom, would qualify as statutory subject matter even under the test as stated by the Examiner because "outputting to the user, from an outputting device of the vending machine, an indication of the availability of the item at the at least one other vending machine" is a "useful, concrete, tangible result." Therefore, Applicants submit that independent claim 23, as amended (to include the limitations of previously presented claim 24), and those depending therefrom, are statutory subject matter, and respectfully request withdrawal of this rejection.

Claim Rejections - 35 USC § 112

Claims 3, 5, 6, 16, 17, 23-34 and 50 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3, 5, 6, 16, and 17, the Examiner states the claims are indefinite because the metes and bounds of the claim can not be determined. For example, with respect to claim 3, the Examiner states that it is unclear if the phrase "transmitting" is 'in addition to,' or 'in replacement of,' the phrase "transmitting" as recited in claim 1. Respectfully, the Applicants submit the claims are not indefinite. "Further comprising" and "wherein" have well-established meaning in patent law. Specifically, "further comprising" is used to introduce an additional element, while "wherein" is used to further characterize a previously introduced element. Applicants have reviewed each of the claims and, where necessary, made amendments to ensure that these terms are used properly. Regarding the Examiner's argument that claim 3 is indefinite because it is unclear whether "transmitting" means "in addition to" or "in replacement of" the term "transmitting" recited in claim 1 Applicants submit that the recitation of "transmitting" in the rejected claims is neither "in addition to" or "in

replacement of" the term "transmitting" recited in claim 1. Rather, "transmitting" in claim 3 is a reference back to the transmitting of claim 1 and provides further characterization. Claim 1 recites only that a request for an item is transmitted, while claim 3 further characterizes the transmitted request as being transmitted to a particular vending machine. Thus, claim 3 further limits claim 1 and is, therefore, a proper dependent claim. The same argument applies to the other rejected claims.

The Examiner further states that claims 23-34 and 50 are indefinite because they are directed to nonstatutory subject matter and therefore can not be construed and that if Applicant overcomes the § 101 rejections noted above, these particular 35 U.S.C. §112, second paragraph rejections will be withdrawn. Applicants respectfully submit that the § 101 rejections have been traversed and respectfully request withdrawal of this rejection.

Claim Rejections - 35 USC § 102

Claims 1-18, 23,-34, and 48-50, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by *Paulucci et. al.* (U.S. 2002/000460 A1)(hereinafter *Paulucci*). Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that the Examiner's rejection refers to *Paulucci et al.* U.S. 2002/000460 A1. However, Applicants were unable to locate such a reference and note that the reference cited in the PTO-892 form refers to *Paulucci et al.* U.S. 2002/0004690 A1. Accordingly, it is presumed that the rejection is based on *Paulucci et al.* U.S. 2002/0004690 A1.

The Examiner concludes without elaboration that *Paulucci* "discloses the claimed invention including a first vending machine that receives a response indicating whether the item is available at another vending machine (the second vending machine)." (Examiner's Action, page 5.) The Examiner provides no citation to the particular portion of *Paulucci* that is believed to support the Examiner's conclusion. Accordingly, Applicants carefully reviewed *Paulucci* in its entirety and determined that *Paulucci* does not teach a first vending machine that receives a response indicating whether the item is available at another vending machine. The portion of *Paulucci* directed to more than

PATENT

Att. Dkt. No. ROC920010084US1

one vending machine is found at paragraph 0080 *et seq.* However, *Paulucci's* reference to one or more vending machines is in fact an integrated vending machine with two vending compartments. (See, Figure 7 and corresponding text.) *Paulucci* specifically teaches that the purpose of having multiple vending compartments is to allow vending of different kinds of products. (See, Paragraph 0081.) For example, one vending machine (compartment) could sell large family style dinners and the other vending machine (compartment) could sell small single serving dinners. (Paragraph 0081, lines 2-5.) In no case does *Paulucci* teach that the various vending machines sell the same items. In fact, *Paulucci* specifically teaches away from doing so since whole purpose of having the multiple vending machines is to support vending disparate item types. (See, paragraph 0081.) Accordingly, it follows that *Paulucci* can not, and does not, teach a first vending machine that receives a response indicating whether the item is available at a second vending machine, where both the first and second vending machines are configured to dispense the same requested item (when stocked) as claimed. Therefore, the claims are believe to be allowable and allowance of the same is respectfully requested.

Claim Rejections - 35 USC §103

Claims 1-18, 23,-34, and 48-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Paulucci*. Respectfully, the Applicants traverse the rejection.

The Examiner states:

"It is the Examiner's principle position that the claims are anticipated because a network connection is inherent. However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify *Paulucci* to include placing the second vending machine in a different location with a network connection between the two. Such a modification would have allowed the vending machines to sell or objects since inventory would be known to the first vending machine."

As an initial matter, Applicants submit that since the Examiner's 102 rejection based on *Paulucci* is believed to have been overcome for the reasons given above, the

Page 10

RF0A-100804

PATENT

Atty. Dkt. No. ROC920010084US1

present combination rejection is also believed to have been overcome. Therefore, the claims are believed to be allowable, and allowance of the same is respectfully requested.

Separately, Applicants submit that the network connection is not inherent in *Paulucci*, as suggested by the Examiner. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted); see also, MPEP 2112 (IV). In this case, a network connection is not necessary in *Paulucci* and, therefore, not inherent. *Paulucci* specifically teaches that the vending machines are integrated and share a common payment acceptor 32, a common selection mechanism 30 and a common control unit 28. (Paragraph 0080, lines 9-11.) Thus, *Paulucci* does not teach networked connections between vending machines.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Joseph M. Jong, Registration No. 42,698
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)

Page 11

RFOA-100804